

The rejection of claims 1 to 3 and 17 to 25 "under 35 U.S.C. § 103 as being unpatentable over Brattsand et al. '233" is respectfully traversed. This reference neither discloses nor suggests any compounds wherein R₁ (of Applicants' claim 1) is cyclohexyl. As previously noted, the cyclohexane ring is recognized by the PTO as being significantly different from the corresponding substituents contemplated by this reference. Certainly, such ring (in context) would not in any way be "obvious" from Brattsand's teachings.

In addition to the preceding arguments, claims 21 to 23 define to an even greater extent over Brattsand '233. Example 16, 22 and 24 of this reference have been identified by the PTO as closest prior art. However, these compounds do not in any way render the compound of claim 21 (or the isomer of either claim 22 or claim 23) "obvious", since this compound differs in three respects from the compounds which are said to be closest prior art:

- a) the 21-position of Brattsand's Examples 16, 22 and 24 is esterified with an acetyl group, whereas the compound of claim 21 carries an isobutyryl group at that position;
- b) in the reference Examples 16, 22 and 24 the 9-position is fluorinated; the compound of Applicants' claim 21 has a hydrogen atom at that position;
- c) the substituent R in the reference Examples 16, 22 and 24 is propyl or butyl, whereas the counterpart in Applicants' claim 21 has a cyclohexyl group at that position.

No prior-art suggestion of a cyclohexyl group in the noted position is found. Moreover, nothing is found in the prior art which would stimulate one of ordinary skill in the art to make a compound with a cyclohexyl group in the subject position. Such a bulky group cannot be regarded as a "homologue" of any prior-art counterpart. As previously pointed out, this was expressly acknowledged by the PTO.

The rejection of claims 2, 3, 22 and 23 "under 35 U.S.C. § 103 as being unpatentable over Brattsand et al. '233 in view of Brattsand et al. '534" is also respectfully traversed in the same manner and for the same reasons as discussed with regard to the immediately-preceding ground of rejection. Like '233, Brattsand '534 neither discloses nor suggests any compound wherein R₁ (of the formula of Applicants' claim 1) comprises a cyclohexane ring. In fact, the PTO expressly acknowledged: "None of the Brattsand et al. compounds possess such a substituent at this position." (See the last complete sentence on page 6 of Paper No. 28.)

The rejection of claims 1, 17 to 21, 24 and 25 "under 35 U.S.C. § 102(a) or (b) as being anticipated by WHO DRUG INFORMATION 3(4) (WHO)" is also respectfully traversed. Prior to Applicants' original filing date (September 7, 1990) in this country, but less than one year before that filing date, the World Health Organization (WHO) published in its Drug Information on International Non-proprietary Names (INN) for a Pharmaceutical Substances the chemical structure and the proposed INN of the

compound because a subsidiary of the principle party in interest in the present application applied for an INN for the compound. In other words the publication was that brought about by or on behalf of Applicants and was effectively derived from information provided by them. Therefore, the information is not available to preclude the patentability of Applicants' present claims.

The rejection of claims 1, 17 to 20, 24 and 25 "under 35 U.S.C. § 102(b) as being anticipated by Acta Pharmaceutica Suecica vol 19, no. 5 (APS-19)" is also respectfully traversed. Applicants note that claims 21 to 23 are omitted from this ground of rejection. In view of the instant amendment to claim 1, claims 1, 17 to 20, 24 and 25 likewise overcome the subject ground of rejection. No disclosure or suggestion is found in this reference for the instant limited meaning of R₁.

The rejections of claims 1, 17 to 20, 24 and 25 "under 35 U.S.C. § 102 (b) as being anticipated by Acta Pharmaceutica Suecica vol. 21 no. 2 (APS-21)" is also respectfully traversed in the same manner and for the same reasons as discussed in the immediately-preceding paragraph.

The rejection of claims 1 to 3 and 17 to 25 "under 35 U.S.C. § 103 as being unpatentable over WHO, APS-19, or APS-21" is also respectfully traversed in the same manner and for the same reasons as discussed in the preceding remarks with regard to each of the individual references relied upon.


CALATAYUD et al. - Serial No. 08/278,112

Having overcome all outstanding grounds of rejection, an early Notice of Allowance is in order and is respectfully solicited.

Respectfully submitted,

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